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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,833	07/21/2003	Richard A. Schumacher	MEMORY-0028	4785
23599	7590	06/08/2007	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			ANDERSON, REBECCA L	
			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			06/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/622,833	SCHUMACHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rebecca L. Anderson	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 02 April 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 2-20 and 23-113 is/are pending in the application.
- 4a) Of the above claim(s) 8-20,23-35,38-50,53-65,68-80,83-95 and 98-110 is/are withdrawn from consideration.
- 5) Claim(s) 113 is/are allowed.
- 6) Claim(s) 2 is/are rejected.
- 7) Claim(s) 2-7,36,37,51,52,66,67,81,82,92,96,97,111 and 112 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 2-20 and 23-113 are currently pending in the instant application. Claims 8-20, 23-35, 38-50, 53-65, 68-80, 83-95 and 98-110 are withdrawn from consideration as being for non-elected subject matter. Claim 2 is rejected. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111 and 112 are objected to as containing non-elected subject matter. Claim 113 appears allowable over the prior art of record. The finality of the previous office action is withdrawn in view of the following non-final rejection.

### ***Petition Decision***

Applicants' petition to review the restriction requirement filed 2 April 2007 was granted in the Petition Decision. Therefore, according to the petition decision the examiner is in error in respect to setting forth a scope of elected subject matter of Group I to which the examination would be limited based on the species identified and therefore, the examiner will follow the guidelines of MPEP 803.02 wherein once a species is elected it is examined for compliance with all applicable statutes for patentability and if compliance is found, then the examination is expanded to a reasonable number of related species to determine whether they also comply with the statute.

The petition states that the examiner will also consider applicants' amendment filed 2 April 2007. Therefore, the amendment to the claims has been entered and as argued by applicants' representative, the examiner will follow the guidelines of MPEP 803.02. Applicants' request is addressed in the instant Office action as the finality of the previous office action has been withdrawn, and the examiner has followed MPEP

803.02.

***Election/Restrictions***

As per the petition decision, the examiner will determine whether the entire scope of the claims is patentable according to MPEP 803.02. Applicants' elected species of N-(3-ethoxy-4-methoxyphenyl)-N-(3-pyridylmethyl)-N-aminbenzoic acid appears allowable over the prior art of record. Therefore, according to MPEP 803.02: should no prior art be found that anticipated or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipated or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The search of the Markush-type claim has been extended to include the products of the formula I wherein:

**R1** is H and alkyl as defined in claim 2;

**R2** is Alkyl as defined in claim 1,

Cycloalkyl as defined in claim 1,

Cycloalkylalkyl as defined in claim 1,

Aryl as defined in claim 1,

Arylalkyl as defined in claim 1, and

A partially unsaturated carboxylic group having 5 to 14 carbon atoms as defined in claim 1;

**R3** is Heteroarylalkyl group, wherein the heteroaryl is pyridyl, the alkyl portion, which is branched or unbranched, has 1 to 5 carbon atoms, the heteroarylalkyl group is

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unsubstituted or substituted one or more times in the heteroaryl portion by halogen, alkyl, alkoxy, cyano, trifluoromethyl, CF<sub>3</sub>O, nitro, oxo, amino, alkyl amino, dialkylamino, or combinations thereof and/or substituted in the alkyl portion by halogen, cyano, or methyl or combinations thereof;

**R4** is Cycloalkyl as defined in claim 1 and aryl as defined in claim 1;

**R5** is H,

Alkyl as defined in claim 1,

Alkylamino or dialkyl amino as defined in claim 1,

A partially unsaturated carbocycle-alkyl group as defined in claim 1,

Cycloalkyl as defined in claim 1,

Cycloalkylalkyl as defined in claim 1,

Aryl as defined in claim 1 and

Arylalkyl as defined in claim 1;

**L** is as defined as in claim 1;

**R6** is as defined in claim 1 and the products of claim 113. Additionally, the search of the Markush-type claims have been extended to the non-elected species of 3,4-dimethoxy-N-(4-methylcyclohexyl)-benzenamine.

As prior art has been found which anticipates the above identified nonelected species of 3,4-dimethoxy-N-(4-methylcyclohexyl)-benzenamine, the Markush-type claims are rejected as follows and the subject matter of the claims drawn to nonelected species held withdrawn from consideration. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, and 111-113 have been examined to the extent that they are readable on the

elected embodiment and the above identified nonelected species. Since art was found on the nonelected species, subject matter not embraced by the elected embodiment or the above identified nonelected species is therefore withdrawn from further consideration.

It has been determined that the entire scope claimed is not patentable.

Additionally, the restriction between Groups I and II is considered proper and is FINAL. In accordance with MPEP 821.04, rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims.

### ***Claim Objections***

Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97 and 111-112 are objected to as containing non-elected subject matter. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97 and 111-112 presented drawn solely to the elected invention for search and examination as identified supra would overcome the instant objection.

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 2 is rejected under 35 U.S.C. 102(a) as being anticipated by 3,4-dimethoxy-N-(4-methycyclohexyl)-benzenamine (Registry No. 416879-93-1) which

corresponds to applicants invention wherein R1 is methyl, R2 is methyl, R3 is H and R4 is cyclohexyl substituted by methyl.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

6 June 2007

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Rebecca Anderson  
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Art Unit 1626, Group 1620  
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